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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,791	01/17/2002	Marvin Jay Pearce	55227 (45105)	7458

21874 7590 04/23/2003

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BOSTON, MA 02209

EXAMINER

WACHSMAN, HAL D

ART UNIT PAPER NUMBER

2857

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/055,791

Applicant(s)

PEARCE, MARVIN JAY

Examiner

Hal D Wachsman

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 4-11 and 15-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

Hal D Wachsman  
Primary Examiner  
Art Unit: 2857

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1. The drawings have been approved by the Draftsperson's.
2. The Abstract is objected to because it is less than 50 words. Appropriate correction is required.
3. The listing of references in the specification (see page 1 of the specification) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
4. The use of the trademarks integritPC, Windows, WindowsCE, Palm and Linux have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. Claims 4-11 and 15-29 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 is a hybrid claim, this is a single claim that claims both an apparatus and the method steps of using the apparatus (see Ex Parte Lyell, 17 USPQ2d 1548 (Bd. Pat. & Inter. 1990)). The preamble of claim 12 sets forth a method for monitoring a patient followed by in part a, "providing a monitoring system comprising...". However, in the remainder of part a as well as in parts b and c, the claim is directed towards the apparatus limitations of the monitoring system. In addition, the Examiner respectfully notes that there is a period at the end of part a even though it is not the end of the claim.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 12-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As already shown in paragraph 7 above, claim 12 is a hybrid claim directed to neither a "process" or a "machine" (see MPEP 2173.05(p)), but rather embracing or overlapping two different statutory classes of

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inventions set forth in 35 U.S.C. 101 which was drafted so as to set forth the statutory classes of invention in the alternative only.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Halpern et al. (5,687,717).

As per claim 1, Halpern et al. (Abstract, figures 1, 4, col. 1 lines 65-67, col. 2 lines 1-5) disclose the one or more patient monitoring units. Halpern et al. (Abstract, figures 1, 2, 4, col. 2 lines 65-67, col. 3 lines 1-6) disclose an electronic module unit to receive data of the one or more monitoring units. Halpern et al. (Abstract, figure 3, col. 2 lines 1, 2, col. 5 lines 35-49, col. 8 lines 11-27) disclose a computer unit for receiving and analysis of data from the module.

As per claim 2, Halpern et al. (Abstract, figures 1, 4, col. 1 lines 65-67, col. 2 lines 1-5) disclose the feature of this claim.

As per claim 3, it is inherent in the art that computers operate on digital signals, therefore any analog signal acquired data would need to be digitized before it can be sent to the computer.

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As per claim 12, Halpern et al. (see at least abstract) disclose providing a monitoring system. Halpern et al. (Abstract, figures 1, 4, col. 1 lines 65-67, col. 2 lines 1-5) disclose the one or more patient monitoring units. Halpern et al. (Abstract, figures 1, 2, 4, col. 2 lines 65-67, col. 3 lines 1-6) disclose an electronic module unit to receive data of the one or more monitoring units. Halpern et al. (Abstract, figure 3, col. 2 lines 1, 2, col. 5 lines 35-49, col. 8 lines 11-27) disclose a computer unit for receiving and analysis of data from the module. Halpern et al. (Abstract, figures 1, 2, 4, col. 2 lines 65-67, col. 3 lines 1-6) disclose the one or more monitoring units providing data to the module unit. With respect to the module unit providing digitized data to the computer unit, it is inherent in the art that computers operate on digital signals, therefore any analog signal acquired data would need to be digitized before it can be sent to the computer.

As per claim 13, Halpern et al. (Abstract, figures 1, 4, col. 1 lines 65-67, col. 2 lines 1-5) disclose the feature of this claim.

As per claim 14, Halpern et al. (col. 5 lines 35-41) disclose the feature of this claim.

12. The following references are cited as being art of general interest: West et al. (6,544,173) which disclose a wireless patient monitoring system, Brown (6,168,563) which discloses a remote health monitoring and maintenance system and Bui et al. (6,398,727) which disclose a patient management system.


13. No claims are allowed.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal D Wachsman whose telephone number is 703-305-9788. The examiner can normally be reached on Monday to Friday 7:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 703-308-1677. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

  
Hal D Wachsman  
Primary Examiner  
Art Unit 2857

HW  
April 19, 2003